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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hartwig Schwier

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EXAMINER

RUTLEDGE, AMELIA L

ART UNIT

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2176

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,870	<b>Applicant(s)</b> SCHWIER ET AL.	
	<b>Examiner</b> AMELIA RUTLEDGE	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 54-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/18/2010</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the following communications: Amendment, filed 02/18/2010; Information Disclosure Statement, filed 02/18/2010.
2. Claims 54-72 are pending. Claims 54, 69, and 70 are independent claims.
3. The drawings were received on 02/18/2010. These drawings are replacement sheets for figures 2 and 3.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Regarding independent claim 69, claim 69 recites "a computer-readable medium comprising a computer program..." The specification does not define the claimed "computer-readable medium" and therefore fails to provide antecedent basis for the claimed subject matter.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 69-72 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding independent claim 69**, claim 69 recites "a computer-readable medium comprising a computer program..." The specification does not define the claimed "computer-readable medium", and as claimed, the medium itself comprises "a computer program", which renders the invention claimed in claim 69 non-statutory under 35 U.S.C. 101, since a computer program alone is not tangibly embodied in any computer hardware.

**Regarding independent claim 70**, claim 70 recites "A system for conversion of an input document data stream.... comprising the steps of: a first converter...." As claimed, claim 70 recites a system comprising "steps", which causes the invention to be directed to non-statutory subject matter.

Further, the claimed system may be reasonably interpreted as being directed to a collection of software modules, not requiring or being embodied on any computer hardware, because the claimed "converters" may be interpreted as embodied in software alone.

**Regarding dependent claims 71 and 72**, claims 71 and 72 are rejected because they add no limitations which would render the claimed subject matter statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 54-60 and 62-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Gebert et al. ("Gebert"), U.S. Pub. No. 2002/0111963 A1, published August 2002, Appl. No. 09/782,850 filed February 2001.**

**Regarding independent claim 54,** Gebert teaches *a method for conversion of an input document data stream that corresponds to one of many possible input data formats into an output document data stream that corresponds to one of many possible input data formats, comprising the steps of: converting the input document data stream into internal data which corresponds to an internal data format;* because Gebert teaches converting a source document in a first presentation language to a result document in a second presentation language (par. 0012-0016).

Gebert teaches *adding as needed document formatting information that establishes how a content of said internal data is represented in the output data format;* because Gebert teaches that the page objects in the result document may be transformed into other presentation languages, including the MO:DCA architecture, page description language (PDS), i.e., PDF, post script, etc (par. 0034; par. 0030-0031). Therefore Gebert teaches creating a result document in an intermediate format, and if necessary, further transforming the result document into page objects in another presentation language.

Gebert teaches *said internal data comprising formatted data that contain format specifications and raw data that contain no format specifications for format-adapted and speed- optimized processing of the input document data stream*; because Gebert teaches converting the pages to rasterized printer data (par. 0029), i.e., raw data, or Intelligent Printer Data Stream (IPDS) format (par. 0028) for format adapted and speed optimized processing. Also see par. 0034 where data is converted to other predetermined formats.

Gebert teaches *said additions of said document formatting information being controlled by a document template, the document template being formed in a first preparatory design phase using a design dataset, and said converting of the input document data stream into the internal data occurring via rules that are based on said design dataset, and also with said design dataset associating types per field in said first preparatory design phase, whereby formatting instructions of said document formatting information are associated with a first type group and no such document formatting instructions are associated with a second type group*, because Gebert teaches XML formatting objects controlled by an XSL stylesheet template (par. 0025-0027), i.e., document formatting information controlled by a document template. Gebert teaches defining a layout master set that includes one or more templates (par. 0023-0024). Gebert teaches formatting some page objects, and that certain of the layout and formatting information may not map to the active environment group, but may be included in the page content, such as the XML code (par. 0027).

Gebert teaches *and whereby in a second processing phase all datasets of the input document data stream are examined by type, and data that are associated with the first type group are additionally formatted and data that are associated with the second type group receive no additional formatting*; Gebert teaches formatting some page objects, and that certain of the layout and formatting information may not map to the active environment group, but may be included in the page content, such as the XML code (par. 0027).

Gebert teaches *converting the data into the output data format*, because Gebert teaches

**Regarding dependent claim 55**, Gebert teaches *wherein for the forming of the document template, said design dataset is formed from the input document data stream and/or from input data-specific auxiliary files*, because Gebert teaches using an XSL style sheet to transform an XML source document including XSL formatting objects, therefore Gebert discloses mapping formatting rules from the input document datastream into a design dataset (par. 0023-0024). Gebert teaches defining a layout master set that includes one or more templates (par. 0023-0024).

**Regarding dependent claim 56**, Gebert teaches *wherein the formatted data are added to the raw data by means of predetermined rules and said output data stream has a predetermined format and is formed from the formatted data of the internal data format*; because Gebert teaches converting the pages to rasterized printer data (par. 0029), or Intelligent Printer Data Stream (IPDS) format (par. 0028) for format adapted

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and speed optimized processing. Also see par. 0034 where data is converted to other predetermined formats.

Gebert teaches defining a layout master set that includes one or more templates (par. 0023-0024). Gebert teaches formatting some page objects, and that certain of the layout and formatting information may not map to the active environment group, but may be included in the page content, such as the XML code (par. 0027).

**Regarding dependent claim 57**, Gebert teaches *wherein the document template is generated using free programmed static or dynamic elements*; because Gebert teaches DHTML, Dynamic Hypertext Mark-Up language, which includes dynamic elements (par. 0044). Gebert also teaches a different presentation language to generate the template (par. 0026-0027).

**Regarding dependent claim 58**, Gebert teaches *wherein a freely definable rule file is formed in a design phase, mapping rules of which rule file are automatically derived or derived such that they are freely editable from the design set, from the input document data, or from other rules from auxiliary files*, because Gebert teaches using an XSL style sheet to transform an XML source document including XSL formatting objects, therefore Gebert discloses mapping formatting rules in a design phase (par. 0023-0024).

**Regarding dependent claim 59**, Gebert teaches *wherein formatted data are converted into a device-specific output data format*; because Gebert teaches converting the pages to rasterized printer data (par. 0029), or Intelligent Printer Data Stream



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(IPDS) format (par. 0028) for format adapted and speed optimized processing. Also see par. 0034 where data is converted to other predetermined formats.

**Regarding dependent claim 60**, Gebert teaches *wherein a normalized data stream or a formatted data stream are device-specifically optimized*; because Gebert teaches converting the pages to rasterized printer data (par. 0029), or Intelligent Printer Data Stream (IPDS) format (par. 0028) for format adapted and speed optimized processing. Also see par. 0034 where data is converted to other predetermined formats.

**Regarding dependent claim 62**, Gebert teaches wherein the raw data are used multiple times in components in the second processing stage (par. 0025-0026; par. 0023).

**Regarding dependent claim 63**, Gebert teaches wherein a component comprises graphical elements or indexing information (par. 0023).

**Regarding dependent claim 64**, Gebert teaches wherein the document formatting information comprises paper reproduction information (par. 0023).

**Regarding dependent claim 65**, Gebert teaches wherein the document formatting information comprises print pre- or post-processing information (par. 0023).

**Regarding dependent claim 66**, Gebert teaches wherein the input data stream comprises an SAP/RDI data stream, a line data stream, or a metacode data stream (par. 0025).

**Regarding dependent claim 67**, Gebert teaches *wherein the output document data stream comprises an Advanced Function Presentation data stream in which a first*

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*group of formatting information is provided via a pagedef file and a second group of formatting information is contained in the input document data stream or in a normalized raw data stream*; because Gebert teaches converting page objects into a device independent page description language (PDL) data stream, and then perform a further transform from the PDL data stream to printer ready raster data in a manner known in the art (par. 0035-0036).

**Regarding dependent claim 68**, Gebert teaches wherein activation signals for a display medium or a computer comprising a display medium are formed from a normalized output document data stream (par. 0044).

**Regarding independent claim 69**, claim 69 is directed to the computer readable medium for implementing the methods claimed in independent claim 54, and is rejected along the same rationale.

**Regarding independent claim 70**, claim 70 is directed to the system for implementing the methods claimed in independent claim 54, and is rejected along the same rationale.

**Regarding dependent claim 71**, Gebert teaches a data processing system (par. 0022).

**Regarding dependent claim 72**, Gebert teaches a data processing printing system (par. 0022).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert.**

**Regarding dependent claim 61**, Gebert does not explicitly teach *wherein the input data format, the output data format, or the document formatting information to be added are selectable*, however, Gebert does disclose an implementation using a printer driver (par. 0022). It would have been obvious to one of ordinary skill in the art at the time of the invention that the input data format, output data format, and document formatting information could be selectable, because at the time of the invention, printer drivers allowed the user to select document formatting information and data formats, therefore it would have been obvious and desirable to combine the prior art elements of document format conversion and printer driver to achieve predictable results.

***Response to Arguments***

Applicant's arguments filed 02/18/2010 have been fully considered but they are not persuasive. Applicant's arguments with respect to new claims 54-72 have been considered but are moot in view of the new ground(s) of rejection, Gebert, which is

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being relied upon to teach the newly claimed limitations of new claims 54-72, all previously pending claims having been canceled by applicant.

While claims 54-72 are newly claimed, it is noted that new claim 54 contains limitations which are similar to the combined limitations of canceled claims 28, 30, and 34, respectively; and new claims 69 and 70 are directed to the computer readable medium and system for implementing the method of claim 54. The new dependent claims are also substantially similar to the prior canceled dependent claims. However, new independent claims 54, 69, and 70 also present new limitations, which changed the scope of the claims, and required the new grounds of rejection.

Applicant presents arguments regarding the reference previously used to reject the canceled claims, Gebert (see Remarks, p. 8-11), which are addressed below in the interest of furthering prosecution.

In response to applicant's argument that Gebert does not disclose *said internal data comprising formatted data that contain format specifications and raw data that contain no format specifications for format-adapted and speed- optimized processing of the input document data stream*; (Remarks, p. 8-9) Gebert does teach converting the pages to rasterized printer data (par. 0029), i.e., raw data, or Intelligent Printer Data Stream (IPDS) format (par. 0028) for format adapted and speed optimized processing. Also see par. 0034 where data is converted to other predetermined formats.

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In response to applicant's argument that the references fail to show certain features of applicant's invention (Remarks, p. 9-11), it is noted that the features upon which applicant relies (i.e., that the document template is not included in a data stream) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, the claims must be given the broadest reasonable interpretation in light of the specification.

MPEP 2106 cites:

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

In this case, it is the examiner's opinion that as claimed, the scope of claims 54-72 is sufficiently broad that each and every limitation of the claimed invention is disclosed by Gebert, and therefore the claim rejections should be maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amelia Rutledge/

Primary Examiner, Art Unit 2176